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10/809,889	03/26/2004	Yoshifumi Tanimoto	042089	7798
38834 7590 04/15/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
SAMS, MATTHEW C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,889

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

MATTHEW C. SAMS

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the applicant's arguments filed on 2/7/2008.

Response to Arguments

2. Applicant's arguments filed 2/7/2008 have been fully considered but they are not persuasive.
3. In response to the applicant's argument regarding claim 13 that "Li fails to disclose an instant message (IM) server" (Pages 2-3), the examiner disagrees.

Clearly, Li teaches the invention does not necessarily require a dedicated server (Page 3 [0029] "(optional) dedicated server device 106"), that the communication system model (Fig. 3 [300]) can be implemented "through logic provided in a peer computer 102". (Page 6 [0076-0077]) However, just because Li teaches the invention can be implemented without a dedicated server does not mean Li does not teach an instant message server.

Li teaches the "dedicated server device 106" can be the "central authority" for assigning universally unique identifiers for each user in the network (Page 3 [0032 & 0034]) and "a request message to the new buddy user can be stored by server device 106 and provided to the buddy user when he/she comes online again". (Page 7 [0090]) Further, Li teaches regarding communication system model (Fig. 3 [300]) that "all or part of which can be implemented, for example, through logic provided in a peer computer 102". (Page 6 [0076]) Therefore, one of ordinary skill in the art would recognize that

the "User Interface Layer 302" would be implemented on the peer computer (Fig. 2A [102] and Pages 6-7 [0083-0088]), but that it is a design choice as to whether Function Logic Layer and P2P Network Layer (Fig. 3 [304 & 306]) are implemented in the dedicated server device (Fig. 2A [106] & Page 7 [0090]) or in the peer computer (Page 6 [0076]), as both options are taught by Li.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US-2003/0182428 hereinafter, Li).

Regarding claim 13, Li teaches a communication method comprising the steps of:

detecting by a terminal of a forwarder, whether or not a user of a terminal of a forwarding destination is logged in an instant message server; (Page 2 [0010] *i.e.* "the resulting P2P communication service/network allows users to remain aware of others' online/offline statuses")

transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a

communication device when the user of the forwarding destination is not logged in the instant message server; (Page 8 [0105])

storing the instant message received from the terminal of the forwarder in means for storing of the communication device; (Fig. 3 [340 & 348])

detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the forwarding destination is logged in the instant message server; (Page 2 [0010]) and

transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination when the user of the forwarding destination logs into the instant message server; (Page 8 [0105])

wherein when the user of the forwarding destination logs in (Page 7 [0094]), the buffered messages saved for the forwarding destination address are transmitted to the destination when a connection is established. (Page 8 [0105])

Li differs from the claimed invention by not explicitly reciting the forwarding destination information corresponding to the logged-in user of the forwarding destination is extracted from a forwarding destination column of the stored instant message, the extracted forwarding destination information is set as a destination, and the instant message is transmitted to the terminal of the set destination.

However, Li teaches typically, instant messages are routed through an IM server (*i.e.* originally addressed to a server...) to get to the respective target destination. (...which forwards the message to the target buddy Page 6 [0078] and Fig. 3 [300] *i.e.* the user interface [302] is used to generate the instant message, then the message is

sent to the function logic layer [304] for either storage [330] or processing [322, 324 or 326] by the dedicated server Page 7 [0090] prior to determining the optimal route [350] to the destination peer computer [102])

Although Li does not explicitly recite “extracting” [a forwarding destination from a] “forwarding destination column”, it is obvious to one of ordinary skill in the art that the instant message is required to be routed through a IM server (Fig. 3 [314, 306 & 350], Page 4 [0038], Page 6 [0076] and Page 7 [0090] *i.e.* regardless of whether the communication system model is implemented in the peer computer or in a dedicated server) and that the forwarding destination column is analogous to the buddy user information (Fig. 4 [400]), which is analyzed by the system in order to forward the buffered instant message to the correct mobile subscriber when a connection is reestablished between user and the peer-to-peer network. (Page 7 [0090] & Page 8 [0105])

Further, it is obvious that one of ordinary skill in the art would have been motivated to implement the use of a dedicated server device for logic layers (Fig. 3 [304 & 306]) because it takes the burden of determining when a destination peer computer is available for receiving a delayed sending task away from the peer computer storing the message. (Page 7 [0090] and Fig. 3 [330])

6. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Dorenbosch et al. (US-2002/0173308 hereinafter, Dorenbosch).

Regarding claim 14, Li teaches the limitations of claim 13 above, but differs from the claimed invention by not explicitly reciting adding to an instant message to be

transmitted from the communication device to the terminal of the forwarding destination, transmitter information included in the instant message which the communication device received from the terminal of the forwarder.

In an analogous art, Dorenbosch teaches an instant message proxy for a communication method in a mobile environment that includes adding to an instant message to be transmitted from the communication device to the terminal of the forwarding destination, transmitter information included in the instant message which the communication device received from the terminal of the forwarder. (Dorenbosch Fig. 3, Page 2 [0021] and Page 3 [0032]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the communication method of Li after modifying it to incorporate the IM proxy of Dorenbosch. One of ordinary skill in the art would have been motivated to do this since Dorenbosch enables instant messaging for mobile subscribers which can be a more convenient/user friendly method of communication for users. (Page 1 [0002-0005])

Regarding claim 15, Li in view of Dorenbosch teaches the step of transmitting, when a prescribed period of time elapses after the communication device receives the instant message from the terminal of the forwarder, an instant message indicating such a fact from the communication device to the terminal of the forwarder. (Dorenbosch Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 16, Li in view of Dorenbosch teaches the step of transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination without intervening the communication device when the user of the

forwarding destination is logged in the instant message server. (Dorenbosch Page 2 [0020] through Page 3 [0027])

Regarding claim 17, Li in view of Dorenbosch teaches a means for detecting whether or not the user is logged in server. (Dorenbosch Page 2 [0023])

Regarding claim 18, Li in view of Dorenbosch teaches receiving a first instant message including a transmission destination, a transmitter, a forwarding destination and main text from the terminal of the forwarder. (Dorenbosch Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 19, Li in view of Dorenbosch teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text as an instant message to be transmitted to the terminal of the forwarding destination in accordance with the first instant message. (Dorenbosch Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US-2002/0165000 to Fok regarding instant messaging to a mobile device.
- US-6,957,077 to Dehlin regarding a system and method for enabling instant messaging on a mobile device.
- US-7,319,882 to Mendiola et al. regarding a messaging system involving wireless communications.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW C. SAMS whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571)272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/M. C. S./

Examiner, Art Unit 2617